

MAY 22 2008

PATENT

Atty Docket No.: 200312030-1
App. Ser. No.: 10/614,856REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

By virtue of the amendments above, claim 1 has been amended and claims 37-54 have been added. In addition, claims 13-36 have been canceled without prejudice or disclaimer of the subject matter contained therein. Accordingly, claims 1-12 and 37-54 are pending in the present application, of which claims 1, 43, and 49 are independent.

No new matter has been introduced by way of the claim amendments or additions; entry thereof is therefore respectfully requested.

Election/Restriction

The Official Action indicates that Claims 13-36 have been withdrawn from further consideration as being drawn to non-elected inventions. The Official Action basically reiterates the reasons set forth in the original Restriction Requirement as the bases for maintaining the restriction. Although the Applicants respectfully disagree with the validity of the Restriction Requirement and believe that it is clearly improper for at least the reasons set forth in the response to Restriction Requirement filed on January 7, 2008, the Applicants have canceled non-elected Claims 13-36 without prejudice or disclaimer of the subject matter contained therein to further prosecution of the present application.

Drawings

The indication that the Drawings submitted on July 9, 2003 have been approved is noted with appreciation.

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Claim Rejection Under 35 U.S.C. §112

Claims 1-12 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended in minor respects to better comply with the provisions of 35 U.S.C. § 112, second paragraph. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 1-12.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

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Claims 1-10 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,546,315 to Kleinschnitz. This rejection is respectfully traversed for at least the following reasons.

Independent claim 1, as amended, pertains to a system for managing inventory of components in a room comprising, *inter alia*, a plurality of identification devices affixed to respective associated components. The plurality of identification devices are configured to communicate identification information relating to the respective associated components and also comprise respective digital displays configured to display the identification information.

Support for the amendments to independent claim 1 may at least be found in lines 10-23 on page 12 of the originally filed specification. In one regard, the digital displays of the present identification devices generally enable the identification information to be modified in a relatively easy manner, since the identification devices need not be replaced or physically altered when the components are moved or replaced.

In rejecting independent claim 1, the Official Action relies upon the disclosure contained in Kleinschnitz. More particularly, the Official Action relies upon column 8, lines 7-30 of Kleinschnitz, which discloses a media library subsystem in which a robot gripper hand 207 includes a bar code scanner 307 that reads labels on media cartridges stored in cartridge access magazines 202. The labels on the media cartridges comprise bar codes to uniquely identify each of the media cartridges. Column 7, lines 44-46.

In contrast to the features claimed in independent claim 1, Kleinschnitz fails to disclose that the bar code labels comprise respective digital displays. Kleinschnitz thus fails to disclose a system for managing inventory of components in a room comprising a plurality of identification devices having respective digital displays configured to display

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identification information relating to respective associated components as claimed in independent claim 1.

For at least the foregoing reasons, Kleinschnitz fails to disclose each and every feature of independent claim 1, and therefore cannot anticipate this claim. The Examiner is therefore respectfully requested to withdraw the rejection of independent claim 1 and the claims that depend therefrom to allow these claims.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would

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have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 11 and 12 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,546,315 to Kleinschnitz in view of U.S. Patent No. 5,434,775 to Sims et al. This rejection and is respectfully traversed for at least the following reasons.

The Official Action correctly notes that Kleinschnitz fails to disclose the features of claims 11 and 12. In an effort to make up for these deficiencies, the Official Action relies upon the disclosure contained in Sims. More particularly, the Official Action relies upon

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Sims for its alleged disclosure of the features claimed in claims 11 and 12. Regardless of whether the assertions with respect to Sims are accurate, the Official Action has not, and cannot reasonably rely on Sims to make up for the deficiencies in Kleinschnitz discussed above with respect to independent claim 1.

As such, even assuming for the sake of argument that the combination of Kleinschnitz and Sims as proposed in the Official Action were considered to be proper, the proposed combination would still fail to disclose all of the features of independent claim 1. For instance, the proposed combination still fails to disclose that a plurality of identification devices comprise respective digital displays configured to display identification information relating to respective associated components.

For at least the foregoing reasons, the proposed combination of Kleinschnitz and Sims fails to yield all of the features of independent claim 1, and therefore, a *prima facie* case of obviousness of claims 11 and 12 has not been established under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 11 and 12 and to allow these claims.

Newly Added Claims

New claims 37-54 have been added to further define the scope of the invention. Support for the subject matter contained in claims 37-54 may at least be found in lines 10-23 on page 12 of the originally filed specification. In addition, support for claims 49-54 may additionally be found in Figure 2B and its accompanying description in the Specification.

Claims 37-54 are drawn to a system for managing inventory components in a room comprising a controller and are thus grouped with the claims of elected Group I.

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Claims 37-54 are allowable over the cited documents of record for at least the reasons set forth above with respect to independent claim 1. In addition, the cited documents of record fail to disclose that a plurality of identification devices comprise respective input modules as claimed in claims 37-39 and claims 46-48. The cited documents of record also fail to disclose an imaging device positioned on one of a ceiling and a wall of the room configured to obtain images of a plurality of identification devices, as claimed in independent claim 43. The cited documents of record further fail to disclose that a plurality of identification devices visually display location information pertaining to locations of the respective associated components.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

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Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: May 22, 2008

By



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